

REMARKS

In the September 3, 2003 Office Action, the Examiner rejected the claims under non-statutory double patenting and 35 U.S.C. §§ 102(e) and 103. The Examiner rejected claims 1-49 for non-statutory obviousness-type double patenting based on claims 1-17 of U.S. Patent 5,809,683 to the Applicant. Claims 21, 22, 26, 27, and 32-34 were rejected under 35 U.S.C. § 102(a) in view of U.S. Patent 4,612,722 to Ferrell (hereafter "Ferrell '722"), and claims 23, 24, and 30 were rejected for obviousness under 35 U.S.C. § 103(a) in view of Ferrell '722. The Examiner also rejected claims 21, 25, 29, 35, 36, and 38 under § 102 in view of U.S. Patent 3,628,286 to Mashahiro (hereafter "Mashahiro '286") and rejected claims 28, 37, 44-46, 48 and 49 under § 103(a) in view of Mashahiro '286. In view of the amended claims, the Applicant believes these rejections are improper because the cited art does not disclose, teach, or suggest the claimed invention and as such the Applicant respectfully requests reconsideration of the pending application.

I. REJECTION FOR OBVIOUSNESS-TYPE DOUBLE PATENTING

A rejection for obviousness-type double patenting is analogous to a rejection under 35 U.S.C. § 103, except that the patent supporting the rejection is not considered prior art. Obviousness-type double patenting occurs when the claimed subject matter in a commonly-owned patent is not patentably distinct from that of the claimed invention. That is, the claimed invention is an obvious variation of an invention defined in the claims of another commonly-owned patent.

U.S. Patent 5,809,683 issued to Solomon (hereafter "the '683 Patent") is a commonly-owned patent for the Applicant. The subject invention is a continuation-in-part (CIP) of U.S.

Patent 6,339,894 to Solomon, which is a CIP of U.S. Patent 6,321,480 to Solomon, which is a CIP of U.S. Patent 6,339,893 to Solomon, which is a CIP of the '683 Patent. The '683 Patent covers a waterfowl motion decoy featuring wing and foot appendages that oscillate back and forth is patentably distinct from the waterfowl motion decoy claimed in the invention featuring rotating wing and foot appendages. The independent Claims 1, 14, 21, 35 (36 as amended), and 44 (45 as amended) of the invention are patentably distinct from the claims of the '683 Patent because they claim rotating appendages and not oscillating appendages.

The independent Claims include several elements that are outside the scope of the claims of the '683 Patent making the invention patentably distinct. The '683 Patent discloses a single output (e.g. drive) shaft extending perpendicular to a pair of slots; one slot on each side of the decoy body. The wing and foot appendages in the '683 Patent oscillate back and forth and do not rotate. In contrast, the invention claims at least one appendage connected to and extending outward from the decoy to rotate around a longitudinal axis associated with the appendage. This is not the configuration disclosed and claimed in the '683 Patent.

The '683 Patent discloses a single output (e.g. drive) shaft extending perpendicular to a pair of slots; one slot on each side of the decoy body. The '683 Patent fails to disclose the configuration of rotation of an appendage as claimed in the invention. Rather, the '683 Patent discloses a pair of wing/foot assemblies on a wing support that extend through slots to oscillate back and forth (not rotate) when the decoy is activated. Because of this principal difference, there is no non-statutory obviousness type double patenting in the claims as amended.

II. REJECTIONS UNDER 35 U.S.C. § 102

Claims 21, 22, 26, 27, and 32-34 were rejected as being anticipated by Ferrell '722, and Claims 21, 25, 29, 35, 36, and 38 were rejected as being anticipated by Mashahiro '286. As amended, these claims overcome the Examiner's § 102 rejections.

Ferrell '722 discloses a propeller (not an appendage) connected to a drive shaft proximate to the rear of the decoy. Mashahiro '286 discloses up-down pivoting paddles driven by an offset shaft at the rear of a toy waterfowl body. Neither Ferrell '722 nor Mashahiro '286 discloses, teaches, or suggests attaching an appendage (e.g. wing appendage), proximate to the side of a decoy and rotating around a longitudinal axis associated with that appendage. The Claims, as amended, are distinguishable from Ferrell '722 and Mashahiro '286.

Because neither Ferrell '722 nor Mashahiro '286 disclose the claimed subject matter, independent claims 21 and 36 are allowable. The dependent Claims 22, 25, 26, 27, 29, 33-34, 37 and 39 depend from Claims 21 and 36 respectively and add further limitations to the two independent claims. Because independent claims 21 and 36 are allowable over Ferrell '722 and Mashahiro '286, the Applicant believes these dependent claims containing additional limitations are allowable as well.

III. REJECTIONS UNDER 35 U.S.C. § 103(a)

The Examiner rejected dependent Claims 23, 24, and 30 in view of Ferrell '722. As shown above, the Applicant believes the rejection of the independent Claim 21 has been traversed by the amended claims and are allowable, these dependent claims adding further limitations are likewise allowable. The Examiner rejected independent Claim 45 and

dependent Claims 28, 38, 46, 47, 49, and 50 under § 103 citing Mashahiro '286. Because the Applicant believes the rejection of the independent Claims 21 and 36 has been traversed by these comments and is allowable, the dependent Claims 28 and 38 adding further limitations are likewise allowable. As amended, Applicant believes that independent Claim 45 is allowable, and the dependent Claims 46, 47, 49, and 50 adding further limitations are likewise allowable

For independent Claim 45, Claim 45 has been amended to add the limitation of a rotating drive shaft rotating around a longitudinal axis associated with the appendage. In Mashahiro '286, the appendage structure does not rotate around such a longitudinal axis. Instead, the appendages (paddles only) in Mashahiro '286 pivot up and down. This appendage is attached at the rear to extend from the rear of the body in Mashahiro '286 and is not located in proximate relation to the side of the body, as the claimed wing appendages are located. Because of these differences, Claim 45 is not obvious to one with ordinary skill in the art from the teachings Mashahiro '286, and Mashahiro '286 cannot support a § 103(a) rejection.

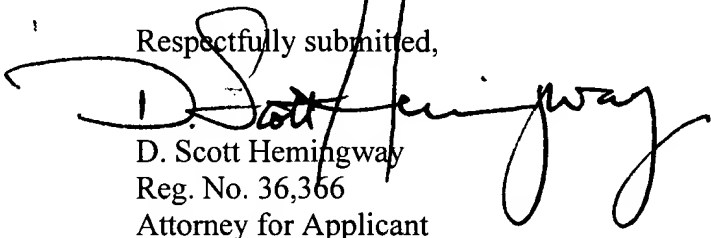
IV. CONCLUSION

The Applicant respectfully requests reconsideration of the present application because the Examiner's double patenting, 35 U.S.C. § 102(a), and § 103(a) rejections are believed to have been traversed by the present Response. As amended, independent Claims 1, 14, 21, 36, and 45 are believed allowable because the cited references fail to disclose all the elements and limitations of the amended claims. Because the dependent claims add further limitations to the allowable independent claims, the Applicant believes the dependent claims are likewise

allowable. Accordingly, pending claims 1-29, 31-50, and new claims 30, 51-55 are believed allowable because the claimed invention is not disclosed, taught, or suggested by the cited references.

It is believed that additional fees are necessary for the two month extension of time and a fee for \$36.00 to pay for four new dependent claims, but that no other fees are necessary at this time. If additional fees are required for filing this response, then the appropriate fees should be deducted from D. Scott Hemingway's Deposit Account No. 501,270.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D. Scott Hemingway", is written over the typed name and title.

D. Scott Hemingway
Reg. No. 36,366
Attorney for Applicant

Storm & Hemingway, LLP
460 Preston Common West
8117 Preston Road
Dallas, Texas 75225
(214)292-8301 (voice)
(214)739-5209 (fax)